UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,562	09/12/2003	Hidekazu Ozawa	117102	5315

25944   7590   04/03/2009
OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

EXAMINER
LETT, THOMAS J

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
04/03/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/660,562	OZAWA ET AL.
	Examiner	**Art Unit**	
	THOMAS J. LETT	2625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>14 January 2009</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1,3-8 and 10-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1,3,4,7,8,10 and 12-14</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>12 September 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☒ All b) ☐ Some * c) ☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/27/08, 8/25/08</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1.　　　　Claims 8 and 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as they do not fall within one of the four statutory categories of invention.　Supreme Court precedent[1] and recent Federal Circuit decisions[2] indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing.　While the instant claims recite a series of steps or acts to be performed, the claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.　The method simply acquires information; and the information is simply described in the dependent claims and this can be done mentally or manually by a user.　Each step requires a particular machine or apparatus such that the step cannot be performed mentally or manually in a manner that reasonably accomplishes the intended purpose of the recited invention, as claimed, without the use of a structure.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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[1] *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

[2] *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

1.   Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

        Claim 6 recites the limitation "the external storage device" in lines 7-8. There is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

        The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1, 3, 4, 7, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by

Mishima et al (USP 20030219272 A1).

        Regarding claim 1, Mishima et al disclose an image processing apparatus (digital copier

1, para. 0032) comprising:

        an acquisition component (receiving CPU 11 of information from a printer driver

processing algorithm, para. 0036) which acquires instruction data which describes process

information, the process information representing a series of processes (instruction data is

acquired to create job data, para. 0036), at least one of the processes to be performed to

document data (print job, para. 0036), and setting information including at least a setting item

and a setting value for setting execution contents of the processes (display attribute settings,

para. 0036);

        an extraction component which extracts from the instruction data the setting information

to be displayed on a display component (CPU 11, para. 0037 initializes display attributes);

a generation component which generates screen information for displaying a screen on the display component on the basis of the setting information extracted by the extraction component (step S52 of processing algorithm of fig. 8), wherein the generation component generates the screen information by obtaining a screen structure on the basis of display specifications of the display component and by applying the setting information to the obtained screen structure (steps S54, S56, S58 of fig. 8); and

the display component (processing algorithm of fig. 8 that changes the screen display), which displays a screen on the basis of the screen information.

Regarding claim 3, Mishima et al disclose an image processing apparatus of claim 1, wherein the generation component includes an interpreting component (step S53 determines if a display attribute is attached) which interprets a display item for defining the screen structure on the basis of the setting information extracted by the extraction component.

Regarding claim 4, Mishima et al disclose an image processing apparatus of claim 1, wherein the acquisition component acquires the instruction data from an external device (e.g., a personal computer 4, para. 0036).

Regarding claim 7, Mishima et al disclose an image processing apparatus of claim 4, wherein the acquisition component can be connected to a server (CPU 11 can be connected via network 10 to a server 5, fig. 1) in which the screen information is stored, and acquires the screen information from the server.

Regarding claim 8, Mishima et al disclose an image processing method which can acquire instruction data which describes process information, the process information representing a series of processes, at least one of the processes to be performed to document data, and setting information including at least a setting item and a setting value for setting execution contents of the processes, the image processing method comprising the steps of:

extracting from the instruction data the setting information to be displayed (CPU 11,

para. 0037 initializes display attributes); and

generating screen information (step S52 of processing algorithm of fig. 8) for displaying

a screen on the basis of the extracted setting information, wherein the screen information is

generated by obtaining a screen structure on the basis of display specifications of a display

component and by applying the setting information to the obtained screen structure; and

displaying the screen on the display component on the basis of the generated screen

information (processing algorithm of fig. 8 that changes the screen display).

Regarding claim 10, Mishima et al disclose an image processing apparatus comprising:

an acquisition component (receiving CPU 11 of information from a printer driver

processing algorithm, para. 0036) which acquires instruction data which describes

process information, the process information representing a series of processes (instruction

data is acquired to create job data, para. 0036), at least one of the processes to be performed to

document data (print job, para. 0036), and setting information including at least a setting item

and a setting value for setting execution contents of the processes, the setting item containing a

certain process of the series of processes to be displayed, the setting value including a

necessary value for the execution of the certain process of the series of processes (display

attribute settings, para. 0036);

an extraction component which extracts from the instruction data the setting information

to be displayed on a display component (CPU 11, para. 0037 initializes display attributes);

a generation component (step S52 of processing algorithm of fig. 8) which generates

screen information for displaying a screen on the display component on the basis of the setting

information extracted by the extraction component, wherein the generation component

generates the screen information by obtaining a screen structure on the basis of display

specifications of the display component and by applying the setting information to the screen structure (steps S54, S56, S58 of fig. 8); and

the display component (processing algorithm of fig. 8 that changes the screen display) which displays a screen on the basis of the screen information.

Allowable Subject Matter

3.   Claims 5, 6, 11 and 15-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS J. LETT whose telephone number is (571)272-7464. The examiner can normally be reached on 8-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS J. LETT/
Examiner, Art Unit 2625